



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,835	07/07/2000	Brent R. Stockwell	50164/002002	6924

21559 7590 03/04/2004

CLARK & ELBING LLP  
101 FEDERAL STREET  
BOSTON, MA 02110

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/611,835

Applicant(s)

STOCKWELL ET AL.

Examiner

My-Chau T. Tran

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89-156 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89-156 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant's amendment filed 12/15/03 is acknowledged and entered. Claims 89, 114, 135, and 149 have been amended.
2. Claims 1-88 have been canceled by the amendment filed on 11/8/02.
3. Claims 89-156 are pending.

### ***Withdrawn Objections and /or Rejections***

4. Applicant's arguments, see page 13, filed 12/15/03, and amendment of claims 89, 114, 135, and 149 with respect to the previous rejection under 35 USC 112, first paragraph (new matter) has been fully considered and are persuasive. The rejection under 35 USC 112, first paragraph (new matter) of claims 89-153 has been withdrawn.
5. Applicant's arguments, see page 14, filed 12/15/03, and amendment of claim 149 with respect to the previous rejections under 35 USC 112, second paragraph, have been fully considered and are persuasive. The rejections under 35 USC 112, second paragraph, of claim 149 have been withdrawn.
6. Applicant's arguments, see pages 14-15, filed 12/15/03, with respect to the rejection of claims 89-156 under 35 USC 103(a) as being unpatentable over Stylli et al. (US Patent

Art Unit: 1639

5,985,214) and Reddy (US Patent 6,017,908) have been fully considered but are moot in view of the new ground of rejection.

***New Rejection***

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 89-148 and 154-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stylli et al. (US Patent 5,985,214).

Stylli et al. teaches an automated method and system for identifying chemicals having useful activity such as biological activities of chemicals and collecting informations resulting from such a process (col. 6, lines 1-24). The method comprise of testing a therapeutic chemical

Art Unit: 1639

for modulating activity of a target such as cell surface proteins in a cell based assay (col. 38, lines 46-67; col. 39, lines 1-9; col. 43, lines 6-9). The method comprises dispensing the reagents (compounds) into the addressable sample wells, which contains a predetermined volume of the sample (test cells) (col. 6, lines 25-40; col. 8, lines 14-18). The method can individually ~~screened~~ <sup>As</sup> at least 25,000 selected and discrete chemicals or chemical libraries wherein the chemicals are structurally related base on activity relationships (i.e. a combination of compounds) (col. 37, lines 44-51). Various method of detection of the compound interaction with the target includes fluorescent measurement such as FRET (fluorescence resonance energy transfer) (col. 27, lines 29-35; col. 28, lines 15-17; col. 39, lines 1-67 thru col. 42, lines 1-23).

The method of Stylli et al. does not expressly disclose that the chemical compounds tested are forty-nine unique combinations of seven different compounds.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include testing of forty-nine unique combinations of seven different compounds in the method of Stylli et al. One of ordinary skill in the art would have been motivated to include testing of forty-nine unique combinations of seven different compounds in the method of Stylli et al. because the number of combinations of compounds to be tested for the affect of biological property would be a choice of experimental design and is considered within the purview of the cited prior art. Additionally, it has been held that “[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA1955). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success in testing of forty-nine unique combinations of seven different compounds

Art Unit: 1639

in the method of Stylli et al. since the taught method would need no modification other than increasing the amount of compound combinations that do not materially affect the method steps.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00 -2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
March 2, 2004

  
**ANDREW WANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**